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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/043,982 | 01/10/2002 | Frank Taverrite | TAVF 101 | 8468 |

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| EXAMINER | |
|---|---|
| HENDERSON, MARK T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3722 | |

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/043,982 | TAVERRITE, FRANK | |
| | Examiner | Art Unit | |
| | Mark T Henderson | 3722 | |

*-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892) ✓
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1 and 2 have been amended for further examination.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Harris (5,923,556).

Harris discloses in Fig. 1A and 1B, a graphic and sound coordinated item: a novelty item (10) having a visible surface (13a and 14a); a main graphic (21) displayed on the visible surface (13); and a complex sound waveform (electrocardiogram (20), as stated in Col. 2, lines 25-51) displayed on the visible surface (14), wherein the complex waveform is associated with the main graphic.

Note, the limitation of the complex waveform being "produced by an acoustic spectrograph" does not structurally limit the claim. The patentability of a product does not depend on its method or production. Product-by-Process claims are not limited to the manipulations of recited steps, only structure implied by the steps. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed Cir. 1985).

In regards to applicant's limitation of a "novelty item", the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the substrate of Harris is capable of being used for novelty purposes.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 2 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Harris in view of Applicant's own admittance.

Harris discloses in Fig. 1A and 1B, a method of promotion comprising: selecting a substrate(10) with a viewing surface (13a and 14a); selecting an image (21) of an activity that promotes an activity to be printed and displayed on the viewing surface (13); selecting a complex

wave form (electrocardiogram 20) of a sound, as stated in Col. 2, lines 25-51) and printing and displaying the waveform on the viewing surface (14).

However, Harris does not disclose the use of an acoustic spectrograph to produce the waveform.

Applicant discloses in the specification on page 2, lines 14-17, that an acoustic spectrograph can be used to produce complex waveforms.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Harris' promoting method by using a spectrograph as taught by Applicant's own admittance to record a sound image which can be printed and displayed as an alternative method of capturing an image of sound waves.

***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Schwartz et al ('824), Schwartz et al ('836), and Kallman disclose a graphic/sound coordinated item. Stewart discloses a spectrograph apparatus to display sound signals.

***Response to Arguments***

4. Applicant's arguments filed on August 25, 2003 have been fully considered but they are not persuasive.

In regards to applicant's argument that the Harris reference does not disclose a waveform "produced by a spectrograph", the examiner submits that the limitation of the complex waveform being "produced by an acoustic spectrograph" does not structurally limit the claim. The patentability of a product does not depend on its method or production. Product-by-Process claims are not limited to the manipulations of recited steps, only structure implied by the steps. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.

In regards to Claim 2, the examiner submits that Applicant's own admittance in the specification discloses that sounds can be produced and displayed by a spectrograph. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Harris' promoting method by using a spectrograph as taught by Applicant's own admittance to record a sound image which can be printed and displayed as an alternative method of capturing an image of sound waves.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

October 31, 2003

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700